

REMARKS

Independent claims 1 and 18 have been cancelled without prejudice or disclaimer. Dependent claims 4 and 20 have been rewritten in independent form. In addition, the limitations of claim 4 have been incorporated into independent claim 29. Claims 2, 7-9, 12, 14-16 have been rewritten to depend from claim 4 instead of claim 1, and claims 19, 21, 27, and 28 have been rewritten to depend from claim 18.

No new matter has been added. Claims 2-4, 7-10, 12, 14-16, 19-23, and 27-29 are now pending for examination.

The Law of Anticipation

In its rejections of the claims under 35 U.S.C. §102(b), the Patent Office has repeatedly failed to show where in Fossel, U.S. Pat. Apl. Pub. No. 2003/0028169 ("Fossel"), the word "breast" appears. To anticipate a claim, the reference applied under §102(b) **must teach every element of the claim**. See M.P.E.P. §2131. The Patent Office has yet to do so, and instead states that "The fact that the human breast is covered by the skin is the matter of the Common Knowledge and [a] number of anatomical sources can be broth [sic] as evidence (i.e., anatomical atlases) by the Applicant's request." However, this is inadequate as a matter of law to show anticipation, which **requires** that the prior art document must describe every element of the claimed invention.

It appears that the Patent Office has conflated an inherency argument (that the skin inherently includes the breast) with its anticipation rejection (that Fossel teaches every element of the claimed invention), since the Patent Office still has yet to find the word "breast" anywhere in Fossel. Instead, it appears that the Patent Office is of the position that because the breast is inherently a portion of the skin, Fossel anticipates the claims because Fossel teaches applying a cream to the skin, which inherently includes the breast. However, this is incorrect because inherency **cannot** be established by mere probabilities or possibilities. The mere fact that a certain thing **may** result from a given set of circumstances is **not** sufficient. See M.P.E.P. §2112(IV). Instead, for the Patent Office to maintain its position that Fossel specifically teaches applying cream to the breasts in order to reject the claims on the grounds of anticipation, the Patent Office **must** therefore show either that: (1) Fossel specifically teaches applying cream to the breasts, and/or (2)

Fossel teaches applying cream to the skin and inherently, **the skin consists of nothing but the breasts**, such that any time someone applies a cream to the skin, that person **necessarily** applies it to the breasts—since the mere fact that a certain thing **may** result from a given set of circumstances is **not** sufficient to find inherent anticipation. The Patent Office has yet to succeed with (1), and (2) is clearly incompatible with “Common Knowledge.”

Rejections under 35 U.S.C. §102(b) in view of Fossel

Claims 1, 3, 7-9, 12, 14, 15, 18, 19, 21, 22, and 27-29 have been rejected under 35 U.S.C. §102(b) as being anticipated by Fossel.

Independent claims 1 and 18 have been cancelled and claims 3, 7-9, 12, 14, 15, 18, 19, 21, 22, 27, and 28 have been rewritten to depend from either claims 4 or 20, which were not rejected on this basis. Accordingly, withdrawal of the rejection of these claims under 35 U.S.C. §102(b) is respectfully requested. With respect to independent claim 29, this claim has been amended to include the limitations of claim 4. Accordingly, it is believed that claim 29, as amended, is not anticipated by Fossel, and it is respectfully requested that the rejection of claim 29 under 35 U.S.C. §102(b) be withdrawn. However, it is not conceded that Fossel anticipates claims 1, 18, or 29 as pending prior to cancellation or amendment herein.

Rejections under 35 U.S.C. §103(a) in view of Fossel

Claims 10 and 23 have been rejected under 35 U.S.C. §103(a) as being unpatentable over Fossel.

Claims 10 and 23 now depend from claims 4 and 20, respectively, due to the above-discussed amendments to the claims. As claims 4 and 20 were not rejected as being anticipated or obvious over Fossel, claims 10 and 23 likewise are not anticipated or rendered obvious over Fossel. Thus, it is respectfully requested that the rejection of claims 10 and 23 be withdrawn.

Rejections under 35 U.S.C. §103(a) in view of Fossel and Nakata

Claim 2 has been rejected under 35 U.S.C. §103(a) as being unpatentable over Fossel in view of Nakata, *et al*, U.S. Pat. No. 5,332,758 (“Nakata”).

Claim 2 has been amended to depend from claim 4, which was not rejected in view of Fossel. Accordingly, since claim 4 is not anticipated by Fossel, it is not seen how claim 2 is anticipated or rendered obvious in view of Fossel. Accordingly, withdrawal of the rejection of claim 2 is respectfully requested.

Rejections under 35 U.S.C. §103(a) in view of Fossel and Cooper

Claims 4 and 20 have been rejected under 35 U.S.C. §103(a) as being unpatentable over Fossel in view of Cooper, U.S. Pat. No. 6,387,081 ("Cooper").

Cooper is directed to an electromechanical device for electrostatically coating a human in an electrostatically attractive powder. The device of Cooper is a fairly technically sophisticated piece of equipment that includes an enclosure large enough to contain a human, various mounts, electrostatic field generators, nozzles, electrical grounding plates, and the like. This is a far cry from a mere topically-applied cream as taught in Fossel, and there accordingly would be no rational or logical reason to combine Fossel with Cooper. Importantly, Cooper specifically **teaches away** from a combination with a topically-applied cream as taught in Fossel, and one of ordinary skill in the art would find no rational reason to ignore the **express** teachings of Cooper in order to combine Cooper with Fossel as suggested by the Patent Office. Cooper states in the "Background of the Invention" (Col. 1, lines 29-44):

Conventional skin coating products, whether designed for cosmetic, treatment or medical purposes, are often liquid or viscous or semi-solid products. Most of them are produced in the form of lotions or creams. These products are traditionally applied by gentle massage or rubbing-in with the fingers. These methods of application necessitate the addition of relatively large amounts of adjunct material, i.e. other than the one or more active ingredients necessary to achieve the desired result. Most of these adjunct materials are added to create an aesthetically acceptable product and act as a carrier to deliver the active agent to all parts of the skin. These known delivery systems are wasteful of cosmetic raw materials and have limited efficiency in delivering a desired active ingredient to an intended site. Control over the applied dosage is difficult and limited and the application of the product itself is often time consuming and messy.

Accordingly, because of this express teaching away, it is not seen how or why one of ordinary skill in the art would attempt to combine the electromechanical device of Cooper with the topically-

applied cream as taught in Fossel in order to arrive at claims 4 and 20, nor is it seen what the result of such a combination would actually be in reality. Thus, claims 4 and 20 are not unpatentable in view of the combination of Cooper and Fossel, and it is accordingly respectfully requested that the rejection of claims 4 and 20 be withdrawn.

Rejections under 35 U.S.C. §103(a) in view of Fossel and Marty

Claim 16 has been rejected under 35 U.S.C. §103(a) as being unpatentable over Fossel in view of Marty, U.S. Pat. No. 4,702,913 ("Marty").

Claim 16 has been amended to depend from claim 4, which was not rejected in view of Fossel. Since claim 4 is not anticipated by Fossel, as previously discussed, claim 16 also cannot be anticipated or rendered obvious in view of Fossel. Accordingly, it is respectfully requested that the rejection of claim 16 be withdrawn.

CONCLUSION

In view of the foregoing, this application should now be in condition for allowance. A notice to this effect is respectfully requested. If the Examiner believes, after this response, that the application is not in condition for allowance, the Examiner is requested to call the undersigned at the telephone number listed below.

If this response is not considered timely filed and if a request for an extension of time is otherwise absent, Applicant hereby requests any necessary extension of time. If there is a fee occasioned by this response, including an extension fee, that is not covered by an enclosed check, please charge our Deposit Account No. 23/2825, under Order No. S1509.70037US01 from which the undersigned is authorized to draw.

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Respectfully submitted,

By 

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